

Remarks

Claims 1-7, 9-16, and 18-27 remain pending in the application.

Claim Rejections — 35 U.S.C. § 103

The Examiner rejects claims 1-7, 9-16, and 18-27 under 35 U.S.C. § 103(a) as obvious over Porcher, Ski Boot, U.S. Patent 4,702,022 (Oct. 27, 1987) in view of Dalvy et al., Internal Liner for a Boot, U.S. Patent 5,924,218 (Jul. 20, 1999) and in view of Mashita et al., Footwear Member, U.S. Patent 5,681,649 (Oct. 28, 1997) under the assertion that Porcher discloses all the limitations, including a liner with multiple resilient layers; that Dalvy teaches a gel pad located between the layers of an inner boot; that Mashita teaches that a gel pad of styrene and butadiene can be located in the toe box area; and that it would have been obvious to place a gel pad in the toe box area as taught by Mashita and to place a pad in the heel area of the liner of Porcher to aid in protection and comfort of the user's foot. With respect to the different hardnesses of the toe box and heel counter, the Office Action asserts that it would have been a mere matter of testing and optimization to find a combination of material that would provide the desired comfort and protection that would meet the desired total hardness of different areas of the boot. The Examiner has not identified any pre-existing motivation to modify prior art.

The Applicant respectfully traverses this obviousness rejection based on a nexus between the unique characteristics of the claimed invention and commercial success of the Applicant's product. Evidence shows that sales were a direct result of the unique characteristics of the claimed invention and not a result of other factors unrelated to the merits of the invention. Evidence supported by a declaration by the Vice President of

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Footwear of DC Shoes, Inc., Jeffery McCall, shows the nexus between the boots having pads disposed as claimed and the commercial success of the boots having the unique features of the present invention. This evidence was submitted previously to the USPTO on March 23, 2004, but was not considered by the Examiner as indicated on page 5, last paragraph, of the Office Action dated July 15, 2004. The USPTO erroneously misfiled our declaration as indicated by this Examiner during a phone call on December 2, 2004. Failure to consider this evidence resulted in the current rejection. The Applicant respectfully requests the evidence be considered, as the evidence submitted is not a mere statement of success. The declaration has been re-submitted with this response for the Examiner's convenience.

The claimed inventions are non-obvious because the claimed inventions have enjoyed outstanding commercial success. To show that the claims are non-obvious, evidence of commercial success must establish a nexus between the claimed inventions and the commercial success. In re Huang, 100 F.3d 135 (Fed. Cir. 1996). The following facts, supported by a declaration by the Vice President of Footwear of DC Shoes, Inc., Jeffery McCall, show the nexus between the boots having pads disposed as claimed and the commercial success of the claimed boots.

In 2003, DC Shoes, Inc., the assignee of this application, sold a total of 57,500 pairs of branded snow boots for all of their branded snow boot configurations. This amount represented 10% of the total worldwide branded snow boot market. Of the total pairs of boots sold in 2003, 32,700 pairs of boots contained a toe pad and a heel pad as claimed in the present application. The sales of the boots with the claimed feature represented approximately 6.5% of the entire **worldwide** branded snow boot market and approximately 57% of **all** snow boot sales by DC Shoes, Inc in 2003.

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In contrast, prior to the introduction of boots utilizing the heel and toe gel pads of the Applicant's invention, DC Shoes, Inc. sold a mere 47,000 pairs of snow boots for all kinds of branded snow boots sold in 2002. This is 10,500 fewer pairs of boots than those pairs sold in 2003. In 2002, prior to introduction of snow boots containing the unique feature, DC Shoes, Inc. only claimed 5.8% of the total worldwide branded snow boot market. With 10% of the total worldwide branded snow boot market in 2003, an increase of 4.2% in **worldwide market share** can be attributed to the unique gel pad feature of the present invention. Further, DC Shoes, Inc. predicted that only 17,000 pairs of the claimed boots would be sold in 2003. However, due to the unique feature of the claimed invention and without any additional marketing, nearly twice as many boots were sold in 2003 (32,700 pairs) than was predicted.

Because DC Shoes, Inc. marketed the claimed boots to the same degree as any other new boot product, the commercial success of the claimed boots flows from the advantage inherent in the claimed boots. The significant difference between prior boots sold by DC Shoes, Inc. and the claimed boots is the inclusion of a pad disposed in the toe box or heel counter area as claimed. This difference was the cause of the dramatic commercial success.

Furthermore, the claimed boots have enjoyed more sales in the first year than any other similar product introduced by DC Shoes, Inc, in the last 6 years despite the fact that the claimed boots were marketed to the same degree as all other previous new boot models. Again, this demonstrates the commercial success of the claimed boots flows directly from the claimed features.

Moreover, the claimed boots have a wholesale price of \$90 per pair of boots. Other DC Shoes, Inc. boots have an average wholesale price of only \$80 per pair of boots. Given the claimed boots are marketed to the same degree as other new DC Shoes, Inc. boots, the reason customers pay more for the claimed boots is due to the fact the claimed boots offer an advantage. The significant

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difference between the claimed boots and other DC Shoes, Inc. boots is the presence of the pads as claimed. Thus, the commercial success of the claimed boots derives from the claimed features.

DC Shoes, Inc. has also received anecdotes indicating the reason why the claimed shoes have enjoyed commercial success is due to the placement of pads in the boots as claimed. DC Shoes has also received anecdotes that professional boot testers found the claimed boots more comfortable during use than other models of branded snow boots due to the placement of the pads as claimed. The sales evidence already provided supports and makes credible the anecdotes received by DC Shoes, Inc. In the light of all of the other evidence presented by the Applicant, the natural conclusion to draw is there is a nexus between the claimed inventions and the commercial success.

Even so, for evidence of commercial success to overcome a finding of obviousness, the marketed boots must also be commensurate with the scope of the claims. In re Tiffin, 448 F.2d 791 (C.C.P.A. 1971). The claims are directed to boots having pads disposed in the toe box and heel counter areas of the boots as claimed. DC Shoes, Inc. is selling boots having exactly these claimed features. Thus, the marketed boots are commensurate with the scope of the claims. Therefore, given that the above facts establish a nexus between the claimed inventions and the evidence of commercial success, and given that the success flows from the functions and advantages disclosed in the specification, the evidence of the commercial success of the claimed boots overcomes the obviousness rejection. Accordingly, the claims are non-obvious.


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Conclusion

This response has addressed all of the Examiner's grounds for rejection. The rejections based on prior art have been traversed. Reconsideration of the rejections and allowance of the claims is requested.

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